



**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Brian William HOLMES et al.

Group Art Unit: 2872

Application No.: 10/520,368

Filed: July 13, 2006

Docket No.: 122347

For: OPTICALLY VARIABLE SECURITY DEVICE

**RENEWED PETITION UNDER 37 C.F.R. §1.497(d)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the October 2007 Decision ("Decision") (copy attached) regarding the above named Applicants' September 13, 2007 Response to Petition ("Response"), and further to the attached Petition for Extension of Time, the following information is provided.

The Decision states that the Applicants Response is being treated under 37 C.F.R. §1.497(d) and sets forth the requirements of §1.497(d). The Decision acknowledges receipt and/or completion of the requirements for a processing fee set forth in §1.17(i), and a new declaration, as stipulated in §1.497(d)(4). Further, the Decision states that (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part, and (2) the written consent of the assignee if an assignment has been executed by any of the original named inventors, have not been provided.

Applicants submit (1) a statement from Dr. Kenneth John Drinkwater stating that his designation as an inventor was done without his knowledge and without any deceptive intent on his part, and (2) a statement of the assignee, executed by Dr. Tim Berridge for De La Rue International, Limited, consenting to the removal of Dr. Drinkwater as a named inventor.

Accordingly, it is respectfully submitted that Brian W. Holmes is the sole named inventor of this application, and that the Declaration submitted September 13, 2007 be accepted in accordance with 37 C.F.R. §1.497(d).

Should any questions arise regarding this correspondence, all inquiries may be directed to Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

Kirk D. Berkheimer  
Registration No. 59,874

JAO:KDB/mab

Attachments:

Copy of U.S. Patent and Trademark Office Decision in response to Applicants' September 13, 2007 "Response to Decision"  
Statement of Dr. Drinkwater dated December 21, 2007  
Statement of Dr. Berridge dated January 28, 2008  
Petition for Extension of Time

Date: February 12, 2008

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

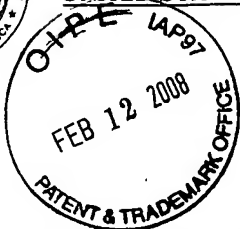
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| <p>DEPOSIT ACCOUNT USE<br/>AUTHORIZATION<br/>Please grant any extension<br/>necessary for entry;<br/>Charge any fee due to our<br/>Deposit Account No. 15-0461</p> |
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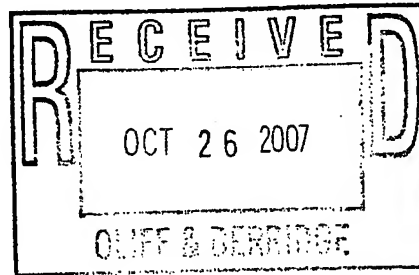
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ALEXANDRIA, VA 22320



DUE DATE

DEC 25 2007

In re Application of HOLMES et al  
U.S. Application No.: 10/520,368  
PCT Application No.: PCT/GB2002/003174  
Int. Filing Date: 10 July 2002  
Priority Date Claimed: (none)  
Attorney Docket No.: 122347  
For: OPTICALLY VARIABLE SECURITY  
DEVICE

DECISION

This is in response to applicant's "Response to Decision" filed 13 September 2007, which is being treated under 37 CFR 1.497(d).

**BACKGROUND**

On 10 July 2002, applicant filed international application PCT/GB2002/003174. A copy of the international application was communicated to the USPTO from the International Bureau on 22 January 2004. The thirty-month period for paying the basic national fee in the United States expired on 10 January 2005.

On 06 January 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 03 May 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 28 June 2006, applicant filed a petition under 37 CFR 1.47(a) along with an executed declaration.

On 13 March 2007, this Office mailed a decision dismissing the 28 June 2006 petition.

On 05 September 2007, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

DOCKETED  
By AWK on 10/26 2007  
and  
By chu on 10/26 2007  
Oliff & Berridge

On 13 September 2007, applicant filed the present petition under 37 CFR 1.497(d).

### DISCUSSION

37 CFR 1.497(d) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

With regard to item (1) above, the requisite statement has not been provided.

With regard to item (2) above, the requisite \$130.00 processing fee will be charged to Deposit Account No. 15-0461.

With regard to item (3) above, the petition fails to state whether an assignment has been executed by any of the original inventors. If such an assignment exists, written consent of the assignee must be provided, and proof of ownership of the assignee must be established. See 37 CFR 3.73(b).

With regard to item (4) above, the requisite new declaration has been provided.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

The Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed 05 September 2007 is hereby VACATED.

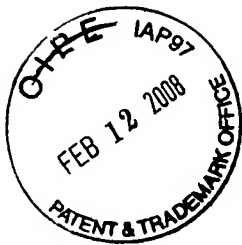
If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

*Bryan Lin*

Bryan Lin  
PCT Legal Examiner  
PCT Legal Office

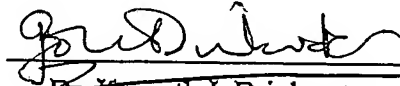
Telephone: 571-272-3303  
Facsimile: 571-273-0459



**STATEMENT of DR. K.J. DRINKWATER  
UNDER 37 C.F.R. §1.497(d)**

I, Dr. Kenneth J. Drinkwater, hereby state that I am not an inventor of International Application PCT \GB02\03174 and pending U.S. National Phase Application Serial No. 10/520368. My designation as an inventor, based on De La Rue International's belief that I was an inventor, was made after my departure from the company and was incorrect. De La Rue International now acknowledges that I am not a named inventor, and was incorrectly listed as one in the International Application and the corresponding U.S. Application. My designation as an inventor was done without my knowledge and without any deceptive intent on my part.

21<sup>ST</sup> December 2007  
Date


  
Dr. Kenneth J. Drinkwater  
46 Guilford Rd  
Fleet  
Hampshire  
GU51 3EY



**STATEMENT OF  
DR. TIM BERRIDGE FOR DE LA RUE INTERNATIONAL, LIMITED,  
UNDER 37 C.F.R. §3.73(b)**

I, Dr. Tim Berridge, Divisional IP Manager-Currency and Security Products, De La Rue, PLC, hereby acknowledge and accept that Dr. Kenneth J. Drinkwater is not an inventor of International Application PCT\GB02\03174, and pending U.S. National Phase Application Serial No. 10/520,368, and hereby agree, on behalf of De La Rue International, to the removal of Dr. Kenneth J. Drinkwater as a named inventor. It is my understanding that the inclusion of Dr. Drinkwater as an inventor in the original filing of this application was done in error and without deceptive intent. An assignment has been recorded in the U.S. Patent and Trademark Office at reel 018831, frame 0670.

28 Jan 2008  
Date

  
Dr. Tim Berridge

  
Witness

Attachment:  
Assignment

C J GASTELL